

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First Named Inventor: HARAI, SATOSHI
Application No.: 10/561503 Confirmation No.: 6419
Filed: July 27, 2004 Group Art Unit: 1794
Title: DOUBLE-SIDED PRESSURE-SENSITIVE ADHESIVE SHEET

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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| June 13, 2008 | /K.J. Rostberg/ |
| Date | Signed by: K.J. Rostberg |

Dear Sir:

In response to the final action dated February 13, 2008, and prior to filing an appeal brief, a Panel Review of the legal and factual basis of the rejections in the above-identified application is hereby requested. No amendments are being filed with this request. This Pre-Appeal Brief and Request for Review is being filed with a Notice of Appeal.

Fees

- ☒ Any required fee will be made at the time of submission via EFS-Web. In the event fees are not or cannot be paid at the time of EFS-Web submission, please charge any fees under 37 CFR § 1.17 which may be required to Deposit Account No. 13-3723.
- ☐ Please charge any fees under 37 CFR §§ 1.16 and 1.17 which may be required to Deposit Account No. 13-3723. (One copy of this sheet marked duplicate is enclosed.)
- ☒ Please charge any additional fees associated with the prosecution of this application to Deposit Account No. 13-3723. This authorization includes the fee for any necessary extension of time under 37 CFR § 1.136(a). To the extent any such extension should become necessary, it is hereby requested.
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REMARKS

Status of the Claims:

Claims 11, 13-16, and 21-26 are pending. Claims 1-10, 12, and 17-20 have been canceled.

Review is requested for the following reasons:

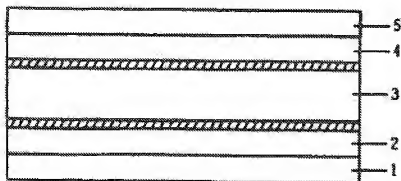
Claims 11, 13-16, and 21-26 were rejected under 35 U.S. C. §102(b) as purportedly being anticipated by JP2002-23663 (JP '663). As the Patent Office has failed to show how JP '663 discloses each element of the claimed invention, the pending rejection under § 102 is improper. Therefore, review and withdrawal of these rejections are respectfully requested.

Independent claim 21

Independent claim 21 provides a double-sided pressure-sensitive sheet comprising, in the following order, a first pressure-sensitive adhesive layer, a first black layer, a flexible base layer, a second black layer, and a second pressure-sensitive adhesive layer. The first pressure-sensitive adhesive layer and second pressure-sensitive adhesive layer are the outermost layers on either side of the double-sided pressure-sensitive sheet. Also, the thickness of the double-sided pressure-sensitive sheet is no greater than 60 μm .

The figure below is from JP '633. Elements 1 and 5 are separators. Both Applicants and the Patent Office agree the separators are not relevant to the claimed structure. (See, e.g., Final Office Action dated February 13, 2008, Section 4.) The remaining elements are described as an adhesive layer (4), a metal vapor deposited layer (the crosshatched layer), a plastic film (3), a second metal vapor deposited layer (the crosshatched layer), and a second adhesive layer (2). (See page 7, [Legend], and the description of FIG. 1 at page 5, paragraph [0013].)

In the Final Office Action, the Patent Office cited page 5, paragraph [0011], lines 10-27 as support for the purported teaching of both a first and a second black layer. However, the cited passage merely refers to possibility of including a white or black pigment in an adhesive layer or the "protective layer." Regardless of whether the adhesive layers of JP '663 may be black, this does not anticipate the present claims which require two black layers in addition to two adhesive layers. Thus, if JP '663 teaches a black layer independent of the adhesive layers, it must be the protective layer.



Referring to page 4, paragraph [0008], JP '663 describes a structure comprising, in order, a separator, and adhesive layer, a metal vapor deposited layer, a substrate, a second metal vapor deposited layer, and some additional "protective layer" which prevents this second metal vapor deposited layer from being exposed. (Additional support for this interpretation can be found at page 3, paragraph [0005] wherein JP '663 defines the phrase "the structure in which metal vapor deposited layer is not exposed on the opposite side of the said adhesive layer.")

Thus, at best, JP '663 may describe an adhesive article that includes one protective layer, but fails to describe, teach or suggest either the presence of or the need for a second protective layer. Therefore, regardless of whether JP '663 may teach that the protective layer may include black pigment, the Examiner has failed to show how JP '663 describes each element of the claimed invention, e.g., two black layers and two adhesive layers.

For at least these reasons, the rejection of independent claim 21 under 35 USC § 102(b) as being anticipated by JP2002-23663 is unwarranted and should be withdrawn.

Independent claim 22

Claim 22 provides in part a double-sided pressure-sensitive sheet comprising, in the following order, a first pressure-sensitive adhesive layer, a first flexible base layer, a first black layer, a lamination layer, a second black layer, a second flexible base layer, and a second pressure-sensitive adhesive layer. The first pressure-sensitive adhesive layer and the second pressure-sensitive adhesive layer are the outermost layers on either side of the double-sided pressure-sensitive sheet, and the thickness of the double-sided pressure-sensitive sheet is no greater than 60 μm .

The Patent Office again relied on FIG. 1 and page 5, paragraph [0011], lines 10-27 of JP '663 as purportedly teaching such a structure. The Patent Office also cited page 3, paragraph [0005]. This passage describes two pieces of plastic film which are each metal vapor coated on one side. The metal vapor deposited layer of one plastic film is adhesive bonded to the second piece of plastic film, which itself is also metal vapor deposited on one side. (See also page 4, paragraph [0008], which also appears to describe such structures.)

Since the black layers of the present invention are patentably distinct from the vapor deposited metal layers of JP '663, Applicants respectfully submit the Patent Office has failed to show how this passage describes, in order, a first black layer, a lamination layer, and a second black layer. Nor has the Patent Office shown how the addition of a protective layer in the locations described by JP '663, even if it did contain black pigment, would anticipate the present claims. For at least these reasons, Applicants respectfully submit that the rejection of claim 22 under 35 USC § 102(b) as being anticipated by JP2002-23663 is unwarranted and should be withdrawn.

Conclusion

By setting forth the clear grounds of error, Appellants do not assert that these are the only errors that the Examiner has made, nor do Appellants waive any arguments that may be asserted in an Appeal Brief. Accordingly, Appellants reserve the right to present additional arguments in the Appeal Brief in relation to the independent and also the dependent claims.

Appellants respectfully request that the Panel review and reverse all pending rejections and that a Panel Decision allowing all pending claims be issued.

Respectfully submitted,

June 13, 2008

Date

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